

Remarks/Arguments

Reconsideration of the above-identified application in view of the following remarks is respectfully requested.

I. Claims

Claims 1, 3, 5, 7, 9, and 10 are pending in the application. Claims 5, 7, and 10 are allowed. Claims 1, 3, and 9 stand rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 2 and 3 of U.S. Patent No. 6,386,583 (hereinafter, "Erike '583") in view of Japanese Patent 410140283 (hereinafter, "JP '283") alone or in view of The ASM Handbook, Volume 4, Heat Treating, 1991, page 164 (hereinafter, the "ASM Handbook").

1. Rejection of Claims 1, 3, and 9 on the Ground of Nonstatutory Obviousness-Type Double Patenting

Applicant notes that claims 1 and 3 had previously been rejected, in an Office Action mailed April 27, 2006, on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 2 and 3 of Erike '583 in view of JP '283 alone or in view of the ASM Handbook. In response to this previous rejection, Terminal Disclaimers were filed on October 26, 2006 and January 22, 2007 on behalf of the assignees of the present application and Erike '583, which are commonly owned. The double patenting rejection was not repeated in the subsequent Office Action and, therefore, appeared to have been withdrawn.

More than two years after the filing of the Terminal Disclaimers, an Office Action mailed September 29, 2009 repeated the foregoing double-patenting rejection as to claims 1 and 3 and also applied the double-patenting rejection to claim 9. The

Office Action stated that the Terminal Disclaimers filed 10/26/06 and 1/22/07 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of Erike '583 had been reviewed and were not accepted. According to the Office Action, the assignee had not established its ownership interest in the patent, in order to support the terminal disclaimer. The Office Action stated that there was no submission in the record establishing the ownership interest by either (a) providing documentary evidence of a chain of title from the original inventor to the assignee and a statement affirming that the documentary evidence was or is currently being submitted for recordation pursuant to 37 CFR 3.11, or (b) specifying (by reel and frame number) where such documentary evidence is recorded in the U.S. Patent and Trademark Office (hereinafter, "USPTO").

In response to the above rejection in the Office Action mailed September 29, 2009, Applicant recorded additional documentary evidence of a chain of title from the original inventor to the assignees. In addition, Applicant discovered that a Terminal Disclaimer Approval Form filed on September 21, 2009 in the USPTO electronic file wrapper for the present application (*but not provided to Applicant*) indicated that the terminal disclaimers dated 10/26/06 and 1/22/07 were disapproved because they did not state the exact interest of the disclaimant. Accordingly, new terminal disclaimers disclaiming the terminal portion of any patent granted on the present application which would extend beyond the expiration date of Erike '583 were filed on behalf of both assignees. Each of the new terminal disclaimers expressly stated, on page 2, that the sectional ownership interest of the assignee is a joint ownership interest.

The Office Action mailed February 17, 2010 yet again repeats the double-patenting rejection of claims 1, 3, and 9 and states that the Terminal Disclaimers filed 10/26/06 and 1/22/07 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of Erike '583 have been reviewed and are not accepted. According to the Office Action, the Terminal Disclaimers do not comply with 37 CFR §1.321(b) and/or (c) because:

(1) the person who has signed the disclaimer has not stated the extent of his/her interest, or the business entity's interest, in the application/patent (37 CFR §1.321(b)(3)) and

(2) an attorney or agent, not of record, has signed the Terminal Disclaimers. A Terminal Disclaimer Approval Form filed on January 30, 2010 in the USPTO electronic file wrapper for the present application (*but not provided to Applicant*) indicates that the terminal disclaimers filed 01/21/10 were disapproved because they did not state "the percentage of interest of both companies" and were signed by person who is not an attorney of record.

In a telephone conversation on or about March 9, 2010, Examiner McGuthry Banks clarified for Applicant's attorney that the Office Action mailed February 17, 2010 should have identified the Terminal Disclaimers as those filed on 1/21/10, rather than those filed on 10/26/06 and 1/22/07. As to the rejection of the Terminal Disclaimers because the person who had signed the disclaimer had failed to state the extent of his/her interest, or the business entity's interest, in the application/patent, Examiner McGuthry Banks referred Applicant's attorney to Director Robert Olszewski, Technology Center 3700.

In a telephone conversation on or about March 9, 2010, Applicant's attorney explained to Director Olszewski that the two joint assignees of the present application and Erike '583 had only agreed to be joint owners of the present application and Erike '583 and had not agreed to a percentage ownership for each assignee. Applicant's attorney also expressed the view that 37 CFR §1.321(b)(3) did not appear to require a statement of a percentage ownership interest for each assignee, contrary to the apparent suggestion in the Terminal Disclaimer Approval Form filed on January 30, 2010. Director Olszewski kindly offered to discuss with the attorneys in the USPTO (a) the need for a statement of a percentage ownership interest in the Terminal Disclaimers and (b) possible alternative language that would be acceptable to the USPTO. In a voice mail communication on March 16, 2010, Director Olszewski advised Applicant's attorney that a statement of a percentage ownership interest of each company was not required in the Terminal Disclaimers, but the Terminal Disclaimers needed to indicate that the assignees submitting the Terminal Disclaimers together owned all of the interest in the present application. Director Olszewski further suggested language for use in two alternative approaches for the Terminal Disclaimers – one approach involving a single Terminal Disclaimer submitted on behalf of both assignees and the other approach involving two Terminal Disclaimers – to make it clear in the Terminal Disclaimer(s) that the two corporate assignees together jointly own all of the ownership interest in the invention of the present application.

Based on the voice mail communication from Director Olszewski, a single new terminal disclaimer disclaiming, on behalf of both assignees, the terminal portion of

any patent granted on the present application which would extend beyond the expiration date of Erike '583 is filed on behalf of both assignees concurrently with this Amendment. The new terminal disclaimer, on page 2, uses language as suggested by Director Olszewski. The new terminal disclaimer is also signed by a registered patent attorney named in the Declaration and Power of Attorney for Patent Application filed on December 3, 2003.

As Applicant has submitted a new terminal disclaimer, signed by an attorney of record and using language regarding the business entity's interest in the application/patent that Applicant's attorney understands is acceptable to the USPTO, disclaiming the terminal portion of any patent granted on the present application which would extend beyond the expiration date of Erike '583, Applicant respectfully requests that the rejection of claims 1, 3, and 9 be withdrawn and that the application be passed to issue.

2. Finality of Rejection

If the rejection of claims 1, 3, and 9 is not withdrawn and the application is not passed to issue, Applicant respectfully requests that the finality of the rejection in the Office Action mailed February 17, 2010 be withdrawn as premature.

In that regard, Applicant notes that the response filed on January 21, 2010 fully addressed the objection to the Terminal Disclaimers filed 10/26/06 and 1/22/07 set out in the Office Action mailed September 29, 2009. Specifically, the Office Action mailed September 29, 2009 objected to the Terminal Disclaimers solely on the ground there was no submission in the record establishing the ownership interest by either (a) providing documentary evidence of a chain of title from the original

inventor to the assignee or (b) specifying (by reel and frame number) where such documentary evidence is recorded in the USPTO. Beyond the objection set out in the Office Action, Applicant discovered the Terminal Disclaimer Approval Form filed on September 21, 2009 in the USPTO electronic file wrapper for the present application (*but not provided to Applicant*) and addressed the issue identified in that Form, namely, that the Terminal Disclaimers dated 10/26/06 and 1/22/07 "do not state the exact interest of disclaimant." This issue was addressed by providing new Terminal Disclaimers in which a space for disclaimant's ownership interest was filled in with the interest agreed between the two assignees, namely, a "joint ownership" interest.

The Office Action mailed on February 17, 2010 objects to the Terminal Disclaimers filed on January 21, 2010 on two new grounds not set out in the Office Action mailed September 29, 2009. These two new grounds are that (1) an attorney or agent, not of record, has signed the Terminal Disclaimers and (2) the person who has signed the disclaimer has not stated the extent of his/her interest, or the business entity's interest, in the application/patent (37 CFR §1.321(b)(3)).

As to the first new ground of objection, Applicant notes that the registered patent attorney who signed the Terminal Disclaimers filed on January 21, 2010 is the same attorney who signed the Terminal Disclaimers filed on 10/26/06 and 1/22/07. Thus, this ground for objection could have been raised in the Office Action mailed September 29, 2009, which would have afforded Applicant an opportunity to address the objection prior to the Office Action mailed on February 17, 2010.

As to the second objection to the Terminal Disclaimers set out in the Office Action mailed on February 17, 2010, Applicant first notes that the Terminal Disclaimers filed on January 21, 2010 have a more complete statement of the disclaimants' ownership interest than the Terminal Disclaimers filed on 10/26/06 and 1/22/07. Thus, if the Terminal Disclaimers filed on January 21, 2010 are not acceptable because they fail to state the extent of the business entity's interest in the application/patent, the Terminal Disclaimers filed on 10/26/06 and 1/22/07 suffered from the same asserted deficiency. This ground for objection could, therefore, have also been raised in the Office Action mailed September 29, 2009, which would have afforded Applicant an opportunity to address the objection prior to the Office Action mailed on February 17, 2010. As to the Terminal Disclaimer Approval Form filed on September 21, 2009 in the USPTO electronic file wrapper for the present application, which was not provided to Applicant, but which Applicant nonetheless discovered, the issue identified in that Form was that the Terminal Disclaimers dated 10/26/06 and 1/22/07 "do not state the exact interest of disclaimant." This issue was addressed by providing new Terminal Disclaimers in which a space for disclaimant's ownership interest, which had been left blank in the Terminal Disclaimers dated 10/26/06 and 1/22/07, was filled in with the ownership interest agreed between the two assignees, namely, a "joint ownership" interest. The Terminal Disclaimer Approval Form filed on January 30, 2010 in the USPTO electronic file wrapper for the present application, which again was not provided to Applicant, but which Applicant nonetheless discovered, identifies the issue with the terminal disclaimers filed 01/21/10 as being that they do not state the percentage of interest of both

companies. This specific issue could also have been raised as an objection to the Terminal Disclaimers filed on 10/26/06 and 1/22/07 in the Office Action mailed September 29, 2009, which again would have afforded Applicant an opportunity to address the objection prior to the Office Action mailed on February 17, 2010.

For all of the foregoing reasons, Applicant respectfully suggests that the rejection of claims 1, 3, and 9 should not have been made final in the Office Action mailed February 17, 2010, and Applicant respectfully requests that the finality of the rejection be withdrawn as premature if the rejection of claims 1, 3, and 9 is not withdrawn and the application is not passed to issue in view of this response to the Office Action.

II. **Conclusion**

In view of the foregoing, it is respectfully submitted that the present application is in condition for allowance, and allowance of the present application is respectfully requested.

Please charge any deficiency or credit any overpayment in the fees for this matter to our Deposit Account No. 20-0090.

Respectfully submitted,

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